

REMARKS

Claims 1-13 are pending in the Application. Claims 1-13 are rejected under 35 U.S.C. §112. Applicants respectfully traverse these rejections for at least the reasons stated below and respectfully request that the Examiner reconsider and withdraw these rejections.

I. REJECTIONS UNDER 35 U.S.C. §112:

The Examiner has rejected claims 1-13 under 35 U.S.C. §112, second paragraph, for allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Office Action (1/12/2006), page 2. In particular, the Examiner asserts that the step of "determining a quality index based on the comparison", as recited in claim 1, and similarly in claims 10, 11 and 13, is unclear. Office Action (1/12/2006), page 2. The Examiner continues by stating:

It's unclear to the Examiner on how the comparison between the foreground and background frequency would change or effect [sic] the quality of the index, since the claims don't disclose any thing related or claims the index or the index quality. The examiner believes there is a missing step between step c, and step d. Clarification is required. Office Action (1/12/2006), page 2.

Applicants respectfully traverse the assertion that Applicants failed to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

A rejection based on Applicants failure to claim the subject matter which Applicants regard as the invention is appropriate only where Applicants have stated, somewhere other than in the application as filed, that the invention is something different from what is defined by the claims. *In re Moore*, 439 F.2d 1232, 169 U.S.P.Q. 236 (C.C.P.A. 1971); M.P.E.P. §2172. The Examiner has not provided any evidence that the invention is something different from what is defined by claims 1, 10, 11 and 13. In fact, the invention is not different from what is defined by claims 1, 10, 11 and 13. Accordingly, Applicants respectfully assert that claims 1-13 are

allowable under 35 U.S.C. §112, second paragraph, and respectfully request the Examiner to withdraw the rejections of claims 1-13 under 35 U.S.C. §112, second paragraph.

Further, a rejection under 35 U.S.C. §112, second paragraph, is not appropriate, when the scope of the claimed subject matter can be determined by one having ordinary skill in the art. M.P.E.P. §2173. Applicants respectfully assert that one having ordinary skill in the art can determine the scope of the limitation of "determining a quality index based on the comparison", as recited in claim 1, and similarly in claims 10, 11 and 13. Applicants respectfully direct the Examiner to page 8, line 1 – page 10, line 9 of the Specification which discusses, in one embodiment, how a quality index is determined based on the comparison between the relative foreground and background frequencies. Claims 1, 10, 11 and 13 clearly set forth the metes and bounds of the patent protection desired in relation to determining a quality index based on the comparison as discussed on page 8, line 1 – page 10, line 9 of the Specification. The Examiner has not provided any evidence that a person of ordinary skill in the art would not be able to determine the scope of the claimed subject matter in claims 1, 10, 11 and 13. One having ordinary skill in the art can determine the scope of the claimed subject matter in claims 1-13. Consequently, Appellants respectfully assert that claims 1-13 are allowable under 35 U.S.C. §112, second paragraph, and respectfully request the Examiner to withdraw the rejections of claims 1-13 under 35 U.S.C. §112, second paragraph.

Further, the Examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. §112, second paragraph, should be whether the claim meets the threshold requirement of clarity and precision, not whether more suitable language or modes of expression are available. M.P.E.P. §2173.02. Definiteness of claim language must be analyzed, not in a vacuum, but in light of the content of the particular application disclosure; the teachings of the prior art; and the claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made. M.P.E.P. §2173.02. In reviewing a claim for compliance with 35 U.S.C. §112, second

paragraph, the Examiner must consider the claim as a whole to determine whether the claim appraises one of ordinary skill in the art of its scope and, therefore, serves the notice function required by 35 U.S.C. §112, second paragraph, by providing clear warning to others as to what constitutes infringement of the patent. *See, e.g., Solomon v. Kimberly-Clark Corp.*, 216 F.3d 1372, 1379, 55 U.S.P.Q.2d 1279, 1283 (Fed. Cir. 2000); M.P.E.P. §2173.02. As shown above, the scope of claims 1, 10, 11 and 13, and in particular the limitation "determining a quality index based on the comparison", when analyzed in light of the Specification, can be determined by one of ordinary skill in the art and therefore serves the notice function required by 35 U.S.C. §112, second paragraph. Consequently, Applicants respectfully assert that claims 1-13 are allowable under 35 U.S.C. §112, second paragraph, and respectfully request the Examiner to withdraw the rejections of claims 1-13 under 35 U.S.C. §112, second paragraph.

Further, the Examiner's basis for his rejection of claims 1, 10, 11 and 13 under 35 U.S.C. §112, second paragraph, is that it is unclear to the Examiner how the comparison between the foreground and background frequencies would change or effect the quality of the index. Office Action (1/12/2006), page 2. Applicants respectfully contend that this ground of rejection does not provide a basis for a rejection under 35 U.S.C. § 112, second paragraph. The purpose of a claim is not to explain technology or how it works. *S3 Inc. v. nVIDIA Corp.*, 59 U.S.P.Q.2d 1745, 1748 (Fed. Cir. 2001). The purpose is to state the legal boundaries of the patent grant. *Id.* Applicants respectfully assert that the claimed subject matter in claims 1-13 can be determined by one having ordinary skill in the art. The rejection under 35 U.S.C. § 112, second paragraph, is not appropriate if the scope of the claimed subject matter can be determined by one having ordinary skill in the art. M.P.E.P. §2173. Consequently, Applicants respectfully assert that claims 1-13 are allowable under 35 U.S.C. § 112, second paragraph, and respectfully request the Examiner to withdraw the rejections under 35 U.S.C. § 112, second paragraph.

Further, in response to the Examiner's statement that the Examiner believes there to be a missing step between steps (c) and (d), Applicants respectfully traverse. Applicants respectfully assert that claims 1, 10, 11 and 13 do not omit matter

disclosed to be essential to the invention as described in the Specification. Accordingly, claims 1-13 are allowable under 35 U.S.C. §112, second paragraph.

Furthermore, the Examiner has not specifically pointed out the essential step deemed to have been omitted from claims 1, 10, 11 and 13. The Examiner must specify the matter disclosed to be essential to the invention in the Specification that was not claimed in claims 1, 10, 11 and 13. *See In re Mayhew*, 527 F.2d 1229, 188 U.S.P.Q. 356 (C.C.P.A. 1976); M.P.E.P. §2172.01. Again, Applicants respectfully assert that claims 1, 10, 11 and 13 do not omit matter disclosed to be essential to the invention as described in the Specification. Accordingly, claims 1-13 are allowable under 35 U.S.C. §112, second paragraph.

Furthermore, a rejection for omitting essential steps is not appropriate under 35 U.S.C. §112, second paragraph. M.P.E.P. §2172.01. Instead, such a rejection is appropriate under 35 U.S.C. §112, first paragraph. M.P.E.P. §2172.01. Accordingly, claims 1-13 are allowable under 35 U.S.C. §112, second paragraph.

II. CONCLUSION

As a result of the foregoing, it is asserted by Applicants that claims 1-13 in the Application are in condition for allowance, and Applicants respectfully request an allowance of such claims. Applicants respectfully request that the Examiner call Applicants' attorney at the below listed number if the Examiner believes that such a discussion would be helpful in resolving any remaining issues.

Respectfully submitted,

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